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09/175,589 10/20/98 JACOBSON

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TM02/0702

EXAMINER

COLBERT, E

ART UNIT

PAPER NUMBER

2172  
DATE MAILED:

07/02/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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|------------------------------|-------------------------------|--------------------------|--|
| <b>Office Action Summary</b> | Applicati n No.<br>09/175,589 | Applicant(s)<br>JACOBSON |  |
|                              | Examiner<br>Ella Colbert      | Art Unit<br>2172         |  |

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. Claims 1-22 are presented for examination. Claims 1, 13, and 17, have been amended in this communication filed 04/23/01, entered as amendment A, paper number 8.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by (US 5,786,817) Sakano et al, hereafter Sakano.

With respect to claim 1 is disclosed by Sakano, note: the claimed, creating an electronic tag that uniquely identifies an electronic record (col. 4, lines 9-16), storing the electronic tag (col. 1, lines 37-58 and fig. 4 (steps 61, 62, & 71-74), distributing the electronic record associated with the electronic tag (col. 2, lines 27-36, col. 4, lines 1-9 and col. 5, lines 29-42).

With respect to claim 2, purging the electronic record comprising the steps of deleting the electronic record and selectively deleting the electronic tag (col. 1, lines 42-49).

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With respect to claim 3, this dependent claim is rejected for the similar rationale given for claim 1.

With respect to claim 4, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 5, a registry and a user profile (col. 4, lines 12-16), analyzing a network user's workstation specifications (col. 2, lines 15-35), analyzing a network user's profile (col. 4, lines 12-16), and generating a reference code, wherein the electronic tag is generated from information analyzed in the network user's workstation specification, the network user's user profile, and the reference code (col. 4, lines 12-65).

With respect to claim 6, reading stored electronic tags and generating an electronic tag in response to accessing an electronic record (col. 4, lines 9-16).

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.

With respect to claim 8, a classification code and an index code (col. 4, lines 36-65).

With respect to claim 9, business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 4, lines 9-16).

The nature of E-mail does not entitle any patentable weight.

With respect to claim 10, index code identifies the contents of an electronic record and the sender or recipient of the electronic record (col. 4, lines 1-16).

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With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 13, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this independent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this independent claim is rejected for the similar rationale given for claim 4.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

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With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

### ***Response to Arguments***

4. Applicant's arguments filed 04/23/01 have been fully considered but they are not persuasive.

With respect Applicants' argument: There is no teaching or suggestion in Sakano that an electronic tag is created and stored at the time an electronic record (e-mail message for example) is distributed is not persuasive because Sakano teaches the step of an electronic tag being created specifically in col. 4, lines 12-16. The storage at the time an electronic record (an e-mail message) is distributed is taught in col. 1, lines 37-58, col. 2, lines 27-36, and fig. 4 (steps 61, 62, 71-75, & 63).

In this rejection of claim 1 and others, for example under Section 102 of Title 35 of the United States code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in Sakano et al. The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

#### **>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION**

*During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPO 541,550-51 (CCA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the section 102 rejection, the examiner explained that the claim was anticipated*

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*by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "(reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. "The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.).<*

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on **Monday-Thursday from 6:30 am -5:00 pm.**


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-96000.

  
E. Colbert  
June 26, 2001

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100